

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ari Ikonen *et al.*

Application No.: 09/587,959

Confirmation No.: 9612

Filed: June 6, 2000

Art Unit: 2623

For: DATA TRANSFER ADAPTOR AND A
METHOD FOR TRANSFERRING DATA

Examiner: J. R. Sheleheda

Certificate of Transmission

I hereby certify that this paper is being filed with the U.S. Patent and Trademark Office by transmission via the Office electronic filing system in accordance with § 1.6(a)(4) on October 10, 2007.

/SCOTT E. KAMHOLZ/
Scott E. Kamholz

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants submit this Reply Brief in response to the Examiner's Answer mailed on August 10, 2007. No fees are believed due, but the Commissioner is authorized to charge any required fee to Deposit Account No. 06-1448, ref. NOD-001.01.

(1) Real Party in Interest

No change from Appeal Brief.

(2) Related Appeals and Interferences

No change from Appeal Brief.

(3) Status of Claims

No change from Appeal Brief. The application has a total of fifty claims. Of these, claims 34-37 are pending and claims 1-33 and 38-50 are cancelled. Claims 34-37 stand finally rejected and are on appeal.

(4) Status of Amendments

No change from Appeal Brief. An amendment was filed subsequent to the final rejection and was entered.

(5) Summary of Claimed Subject Matter

No change from Appeal Brief.

(6) Grounds of Rejection to be Reviewed on Appeal

No change from Appeal Brief. Appellants submit one ground of rejection for review:

A. that the subject matter of claims 34-37 is unpatentable under 35 U.S.C. § 103(a) over European Patent Application EP0804030-A2 to Heinonen et al. ("Heinonen") in view of U.S. Pat. No. 6,202,060 to Tran ("Tran").

(7) Argument

A. Claims 34-37 are patentable over Heinonen in view of Tran.

In his Answer, the Examiner adheres to his rejection of claims 34-37, relying primarily on Heinonen, and continuing to assert that it would be obvious to add Bluetooth-protocol wireless communications, as disclosed by the combination of Tran and the prior art generally, between the mobile telephone and the interface to the television in Heinonen.

Although he maintains his rejection, the Examiner fundamentally changes the argument he offers to support his position, from that taken in his Office Action. But his new basis for the rejection is no more persuasive than his old.

In his Office Action rejection, the Examiner had asserted that although Heinonen's data communications and power transmission were carried out in a unitary device, the two functions could be separated from one another because data and power went through separate pins in Heinonen's connector, and because Heinonen describes data interface cards, which themselves do not conduct charging power. Hence, Bluetooth-protocol wireless data communications as disclosed by the combination of Tran and the general prior art simply could replace the wired communications disclosed by Heinonen.

In their Appeal Brief, Appellants demonstrated that that position was untenable.

In response, in his Answer the Examiner has abandoned that argument. Instead, the Examiner *now* relies on the remarkable assertion that it would be obvious (and appropriate) to maintain Heinonen's system in its entirety and *add* a Bluetooth-protocol wireless system as a *separate and additional* communications link from the mobile telephone to the interface *on top of* Heinonen's wired communications link, even while that link, an integral part of the "interface part 7"/"charger accessory 30," remained. Answer, pp. 8-9 ("[T]he *addition* of a wireless Bluetooth connection would allow the mobile phone user to continue carrying and using their mobile phone in a mobile manner") (emphasis added).

This grafting of a wireless data transmission *on top of* Heinonen, however, produces a system with *two* separate data transmission mechanisms between the phone and the interface. Such a step is not just hindsight; it would contradict Heinonen's entire

approach. In view of Heinonen's repeated emphasis on his desire to provide a system that required minimal new devices for implementation, and his deliberate design of a unitary adapter that both transmitted power and communicated data in order to reduce complexity, the Examiner's addition of a second means of data transmission, which would increase complexity and introduce an additional device, cannot be permitted.

Heinonen's design itself demonstrates that it would not have been obvious to add a Bluetooth-protocol wireless data communications link between the mobile telephone and the interface to the television, as the Examiner suggests with hindsight. When Heinonen chose to use a wired connection, rather than a wireless link, between the phone and the interface, he was clearly well aware of the availability of wireless communication systems. Indeed, the mobile telephone itself in Heinonen communicates with the telephone network over a wireless connection, and Heinonen also discloses using an infra-red communications means, e.g., for control purposes. (See column 4, line 56 to column 5, line 5.) In addition, as the Examiner himself notes in his Answer, "it was notoriously well known in the art at the time of invention by applicant to [use] a format that conforms to a Bluetooth protocol to implement a wireless connection system between a mobile device and other local devices." Answer, p. 5. Thus, Heinonen's decision to use a *wired* communications link to communicate between the mobile telephone and the television interface was *not* made without knowledge and consideration of alternative wireless communications techniques. Were it obvious and advantageous in the context of Heinonen's device to utilize wireless communications in general, and the Bluetooth protocol in particular, between the mobile telephone and the interface, in lieu of a wired

connection, Heinonen could have done so. But he did not, and it was only years later that Heinonen (himself a joint inventor in the present case) appreciated the benefits of such a wireless link between the phone and the interface and so invented the system now claimed.

In fact, Heinonen's decision at the time of his design to utilize a wired connection between the mobile telephone and the television interface was carefully considered and made to further his fundamental design, and not incidental or random. Heinonen didn't utilize a Bluetooth-protocol wireless communications link between the mobile telephone and the interface because such a link would have been pointlessly duplicative when he had already provided a wired connection, and he provided a wired connection for a fundamental reason: in order to permit the transmission of power.

As discussed above, it was important to Heinonen that his system include a *unitary* adapter that functioned *both* for the transmission of power to recharge the mobile telephone battery, *and* as a communications link. Such a *combined* power and data conduit between the mobile phone and the television interface is *central* to the Heinonen disclosure. It is referred to as "an interface part **7**" in Figure 1, and "[t]he charger accessory **30**" in Figure 3, see also, e.g., Heinonen, col. 3, lines 19, 27-28, 44; a substantial part of the specification discusses the structure and functionality of this combined device in transferring *both* power and data to the telephone. Because this single device in Heinonen unites the functions of providing power to recharge the mobile telephone's battery, and providing a communications pathway for the data to flow from the telephone to the television, it furthers Heinonen's expressed goal of providing a simple system with a

minimum of complexity. It is thus an important element of the Heinonen design, not an insignificant detail as suggested by the Examiner.

But in order to accomplish the dual function of power transmission and data transmission in a single device, the connection must be a direct physical connection, and certainly cannot be a Bluetooth-protocol connection. To replace the dual-purpose wired adapter, as previously proposed by the Examiner, one would need a wireless means of simultaneously communicating information *and* transferring enough power to the mobile telephone to power it and charge its battery. But neither Tran, nor Heinonen, nor any other art cited by the Examiner, discloses such a device, because no such device was available in the art at the time, particularly not a device that could transmit both charging power and a signal in a format that conforms to a Bluetooth protocol. (Appellants pointed out previously that the Bluetooth protocol does not provide for power transmission of the magnitude that Heinonen requires for the charging function, and in his Answer the Examiner does not contest the point.) Thus, if one were to replace the “interface part 7”/“charger accessory 30” in Heinonen’s invention with a wireless Bluetooth-protocol device, Heinonen’s mobile telephone could not be charged.

Moreover, the Examiner repeatedly argues in his Answer that it would have been obvious to add a wireless connection between the phone and the interface for greater mobility and flexibility, noting that mobility is a widely known and desirable feature of mobile phones. But the Examiner’s argument is misplaced; the desirable mobility of a mobile phone is achieved by having a wireless connection between the phone and its *phone network*, so that the user can conduct phone calls regardless of location. Heinonen’s

data connection to the interface is separate and distinct from the network connection and is used for transmitting signals to a television *while the user is looking at the television* and therefore not changing location. But even if the user is moving around in the vicinity of the television, Heinonen provides wireless remote control device 5 for the user to control the system. A wireless data connection between the phone and the interface is therefore superfluous to Heinonen's design.

In short, it is not an accident or oversight that Bluetooth-protocol wireless transmission between the mobile telephone and the television interface is *not* disclosed by Heinonen; such a means of data transmission could not be utilized in the dual-purpose adapter which Heinonen considered central to his invention.

For these reasons, Appellants ask that the rejection of claims 34-37 be reversed. The Examiner's combination of a distinct and separate Bluetooth-protocol wireless communications means, with Heinonen's device that *already* intentionally provided for communications by means of a wire connection that also served other functions, is improper, Appellants' design is novel, and claims 34-37 should be allowed.

(8) Claims Appendix

No change from Appeal Brief. See Claims Appendix of this Reply Brief.

(9) Evidence Appendix

No change from Appeal Brief. See Evidence Appendix of this Reply Brief.

(10) Related Proceedings Appendix

No change from Appeal Brief. See Related Proceedings Appendix of this Reply Brief.

CONCLUSION

For the reasons given above and in their initial Appeal Brief, Appellants ask that the rejection of claims 34-37 be reversed.

Respectfully submitted,
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(8) Claims Appendix

Claims 1–33 (Canceled)

34. A method for transferring image and sound data from a mobile phone to a television, comprising:
- generating a signal in the mobile phone from the image and sound data received by the mobile phone;
 - transmitting the signal in a format that conforms to a Bluetooth-protocol as an output signal from the mobile phone;
 - receiving the output signal from the mobile phone as an input signal at a module;
 - converting the input signal to image-sound signals in the module; and
 - connecting the image-sound signals from the module to the television, wherein the module is a mobile telephone accessory located at the television.
35. The method according to claim 34, wherein connecting further comprises transmitting the image-sound signals to the television using a SCART-connection to the television.
36. The method according to claim 34, wherein the image-sound signals are a RGB+sound signal.
37. The method according to claim 34, wherein the television is an analog television.

Claims 38–50 (Canceled)

(9) Evidence Appendix

None.

(10) Related Proceedings Appendix

None.